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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/727,264
Filing Date: December 03, 2003
Appellant(s): GORSLINE ET AL.

Joey C. Yao
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 14 May 2010 appealing from the Office action mailed 14 October 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 46-96 are pending.

Claims 46-96 have been rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is not fully correct. Appellant filed an Amendment After Final on 14 January 2010; however the amendment(s) was not entered.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

- 1) Claims 63-96 being rejected under 35 USC 101

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20020036654	Evans et al	2-2002
20020147645	Alao et al	10-2002
20020188635	Larson et al	12-2002
20030191693	Aphek	4-2002

Adcycle, "Adcycle Support: Getting Started", copy provided published 2/12/2002,
pgs 1-2

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46, 49-52, 54, 55, 59-63, 66-69, 71, 72, 76-80, 83-86, 88, 89, and 93-96 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Adcycle ("Adcycle Support: Getting Started", published early as 2/12/2002, pgs 1-2)

As per independent Claim 46, Evans et al discloses a method comprising:

- receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system; (Paragraph 0058; FIG 3, 302-304 - Discloses a number of advertising formats the user is able to choose from. Once the format is selected, the user chooses from a plurality of templates related to the advertising format. (Paragraph 0063))
- selecting, in accordance with the aggregate creative definition, at least one set of subcreatives of more than one subcreative from a plurality of subcreatives in the advertising system, (Paragraph 0071 discloses the use ad

areas on templates, wherein the template (set) include product references (subcreatives) that include an image reference of the product and text reference; wherein the template includes multiple ad areas (or placement for multiple sets) (Paragraph 0069) In addition, product references also include SKU numbers, barcodes, trademarks, logos, etc. These product references are retrievable from one or more databases. (Paragraph 0076-0077)) Furthermore, the user has the ability to create its own product ad contain product references from a database of product references (Paragraph 0066-0068)

- assembling a plurality of aggregate creative forms, each aggregate creative form comprising one or more of the subsets of subcreatives in accordance with the aggregate creative definition; (Each template may contain multiple ad areas (Paragraph 0069) which each ad area able to contain more than one product references (Paragraph 0068, Page 6, lines 5 – 14; Paragraph 0071. Therefore, Paragraph 0088, Paragraph 0095: Discloses one embodiment wherein a template and a list of product references are submitted to a assistance layout program that lays out the product references into the template. Here, the computer would read the list of product references, select the product reference, obtain the product reference and place it into template based on the instructions of either priority based or order-based from the list. Each product being advertised has multiple product references from which the assistance layout program may choose. Since the program has multiple

- product references to choose from, it provides greater flexibility creating multiple advertisements. Thus a process of creating a computer-created advertisement, hence using a computer that is used to create ads using an automated assembly. Furthermore, it is implicitly known if the Evans et al's method is capable of performing the functionality once, then it may generate the same functionality over again. Thus multiple computer-created advertisements have the functionality to be generated.)
- storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms; and when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission. (Paragraph 0048, Step 314 Claim 1, 16, 39: Discloses the creation/generation of a proposed advertisement that is used to be displayed to the user for authorization. The generation of proposed advertisement is defined as the plurality of product references that has been laid out on the plurality of advertisement areas. Thus, when displaying the proposed advertisement to the user, an "assembled form" is presented. In addition, it is inherently known when any data (i.e. advertisement) is created, its stored in a form of memory such as a memory buffer or in a volatile memory for further operations (i.e. displayed). Furthermore, after

authorization/approval, the proposed (assembled) advertisement may be transmitted to users via a printer, email or posted on a web site by Internet.
(Paragraphs 0052, 0095, Claim 17)

However, Evans et al fails to specifically disclose rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative. However, Adcycle discloses the use of ad groups wherein each group contains multiple ad campaigns (advertisement). The groups are regions on the web page wherein each group rotates the ads based on the ad campaigns in that group. For example, Adcycle disclose the user creating a group to be located on the top of the web page, wherein that group contains multiple ad campaigns, and rotates each ad campaign for each time the group is displayed. Thus, it is implicitly known if Adcycle's method is capable of performing the functionality once for one region, then it may generate another group for a different region. Therefore, Adcycle discloses the ability for multiple locations of ads on the webpage equaling the number of created groups at a time. Each time the groups on the webpage are displayed, a new ad is rotated for display. Thus, each time the web page is view, a different combination of ads are presented based on the rotation of the ads in each group. (Page 1-2)

It would have been obvious to one of ordinary skill in the art at the time of Application's invention to have modified Evan's advertisements creation method with

Adcycle's feature of rotating ads since it would have provided the benefit of a fast and inexpensive method for advertisers that want to place only a limited number of ads.

As per dependent claim 49, Claim 49 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 50, Claim 50 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 51, Claim 51 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 52, Claim 52 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 54, Evans et al discloses the plurality of sets of subcreatives include different numbers of subcreatives. (Paragraph 0066, 0075, 0076)

As per dependent claim 55, Evans et al fails to specifically disclose wherein at least two of the sets of subcreatives share one or more common subcreatives. However, Evans discloses an embodiment of utilize multiple databases of product references wherein one database of references is for advertising nationally, while another database of references is for advertising locally. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that the same product reference be stored and used nationally and locally since it would provide the benefit of getting advertised at a national scale for more attention, but the same time, advertising a product that has well-known positive feedback in a local area.

As per dependent claim 59, Evans et al discloses wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to scheduling criteria for transmission to users. (Paragraph 0093, 0094: Discloses a scheduling process for creating the advertisement and distributing the advertisement)

As per dependent claim 60, Evans et al discloses wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to criteria for targeting transmission to specific users. (e.g. Paragraph 0093, 0094, 0095: Discloses scheduling criteria, user setup criteria)

As per dependent claim 61, Evans et al discloses the aggregate creative definition enables the step of assembling a plurality of aggregate creative forms to occur even if a prescribed number of subcreatives is not available in one of the subsets of subcreatives. (Paragraph 0088, 0095)

As per dependent claim 62, Claim 62 recites similar limitations as in Claim 45 and is similarly rejection under rationale. Furthermore, Evans et al discloses the advertising system is configured to select aggregate creatives and non-aggregate creatives for transmission to users on the electronic network. (Paragraph 0063-0065, 0088, 0095: Template that contains the ad themes is selected to create the advertisement)

As per independent claim 63, Claim 63 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 66, Claim 66 recites similar limitations as in Claim 49 and is similarly rejected under rationale.

As per dependent claim 67, Claim 67 recites similar limitations as in Claim 50 and is similarly rejected under rationale.

As per dependent claim 68, Claim 68 recites similar limitations as in Claim 51 and is similarly rejected under rationale.

As per dependent claim 69, Claim 69 recites similar limitations as in Claim 52 and is similarly rejected under rationale.

As per dependent claim 71, Claim 71 recites similar limitations as in Claim 54 and is similarly rejected under rationale.

As per dependent claim 72, Claim 72 recites similar limitations as in Claim 55 and is similarly rejected under rationale.

As per dependent claim 76, Claim 76 recites similar limitations as in Claim 59 and is similarly rejected under rationale.

As per dependent claim 77, Claim 77 recites similar limitations as in Claim 60 and is similarly rejected under rationale.

As per dependent claim 78, Claim 78 recites similar limitations as in Claim 61 and is similarly rejected under rationale.

As per dependent claim 79, Claim 79 recites similar limitations as in Claim 62 and is similarly rejected under rationale.

As per independent claim 80, Claim 80 recites similar limitations as in Claim 46 and is similarly rejected under rationale.

As per dependent claim 83, Claim 83 recites similar limitations as in Claim 49 and is similarly rejected under rationale.

As per dependent claim 84, Claim 84 recites similar limitations as in Claim 50 and is similarly rejected under rationale.

As per dependent claim 85, Claim 85 recites similar limitations as in Claim 51 and is similarly rejected under rationale.

As per dependent claim 86, Claim 86 recites similar limitations as in Claim 52 and is similarly rejected under rationale.

As per dependent claim 88, Claim 88 recites similar limitations as in Claim 54 and is similarly rejected under rationale.

As per dependent claim 89, Claim 89 recites similar limitations as in Claim 55 and is similarly rejected under rationale.

As per dependent claim 93, Claim 93 recites similar limitations as in Claim 59 and is similarly rejected under rationale.

As per dependent claim 94, Claim 94 recites similar limitations as in Claim 60 and is similarly rejected under rationale.

As per dependent claim 95, Claim 95 recites similar limitations as in Claim 61 and is similarly rejected under rationale.

As per dependent claim 96, Claim 96 recites similar limitations as in Claim 62 and is similarly rejected under rationale.

Claims 47-48, 56, 64-65, 73, 81-82, and 90 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Adcycle ("Adcycle Support: Getting Started", published early as 2/12/2002, pgs 1-2) in further view of Alao et al (US PGPub 20020147645, published 10/10/2002)

As per dependent claims 47-48, and 56, Evans and Yasnovsky et al fail to specifically disclose applying weighting criteria to the selected set of subcreatives in the at least one subcreative pool, wherein the plurality of subsets of subcreatives are selected according to the weighting criteria and wherein the aggregate creative definition includes one or more constraints for the step of selecting at least one set of subcreatives, the one or more constraints determining permitted combinations of subcreatives for the at least one set of subcreatives. Since each subset has at least subcreative or just one, it has a combination of one. Therefore each subset has/is a subcreative. Thus, Alao et al discloses how advertisements are to be chosen based on constraints such as advertisement priority, advertisement weight, minimum advertisement display time, industry exclusions, overall frequency cap, minimum rotation interval, advertisement spec, advertisement type, and advertisement target. (Paragraph 0146, lines 15-21) Alao et al further details how ad-weighting works based on priority. (Paragraph 0146, lines 21-29) These constraints affect the level the priority thus changing the constraints producing a different list of order (combination) of display. Furthermore, when each advertisement item is edited or altered to include weight or

constraints, it is considered generating a new or "copied" advertisement item with weight since it is different than the original unaltered advertisement.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Evans et al and Adcycle with Alao et al's method since Alao et al's method would have provided a method for adaptive delivery of advertisements to a client.

Claims 64-65 recite similar limitations as in Claims 47-48 and are similarly rejected under rationale.

Claims 73 recite similar limitations as in Claim 56 and is similarly rejected under rationale.

Claims 81-82 recite similar limitations as in Claims 47-48 and are similarly rejected under rationale.

Claims 90 recite similar limitations as in Claim 56 and is similarly rejected under rationale.

Claims 53, 58, 70, 75, 87, and 92 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Adcycle ("Adcycle Support: Getting Started", published early as 2/12/2002, pgs 1-2) in further view of Larson (US PG Pub 20020188635, published 12/12/2002, filed 2/1/2002)

As per dependent claim 53, Evans et al discloses wherein the plurality of subcreatives includes graphic subcreatives, text subcreatives, (Paragraph 0071, lines 5-

8) However, Evan et al and Adcycle fail to specifically disclose hyperlink subcreatives. However, Larson et al discloses the advertisement containing active links/hyperlinks linked to the advertiser's web site. (Paragraph 0054-0055)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Evans et al and Adcycle with Larson's disclosure since Larson's disclosure would have provided a quick and easy method to access the advertiser's method by clicking on the advertiser's ad.

As per dependent claim 58, Evans et al and Adcycle fails to specifically disclose the step of tracking transmitted subcreatives transmitted to users on the electronic network. However, Larson discloses collecting statistical information in regards to advertisements such indicating the number of times ads are displayed, and the page the ads are displayed. (Paragraph 0140)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Evan et al and Adcycle's method with Larson's method since Larson's method would have provided digital edition web pages that incorporated preview images of advertising hard copy with collecting statistical information.

As per dependent claim 70, Claim 70 recites similar limitations as in Claim 53 and is similarly rejected under rationale.

As per dependent claim 75, Claim 75 recites similar limitations as in Claim 58 and is similarly rejected under rationale.

As per dependent claim 87, Claim 87 recites similar limitations as in Claim 53 and is similarly rejected under rationale.

As per dependent claim 92, Claim 92 recites similar limitations as in Claim 58 and is similarly rejected under rationale.

Claims 57, 74, and 91 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evan et al (US PGPub 20020036654, published 3/28/2002) in further view of Adcycle ("Adcycle Support: Getting Started", published early as 2/12/2002, pgs 1-2) in further view of Aphek (US PG Pub 20030191693, filed 4/8/2002)

As per dependent claim 57, Evans et al and Adcycle fail to specifically disclose wherein the step of assembling a plurality of aggregate creative forms occurs off-line from when the aggregate creative is selected for transmission. However, Aphek discloses the ability to create an advertisement off-line using the soft program for creating advertisements before transmitting the advertisement online to a Web server. (Abstract, Paragraph 0010-0011)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified Evan et al's and Adcycle's method with Aphek's method since Aphek's method would have provided the benefit of allowing advertisers to create and update graphical ads in an instant and independent manner without any delays and whenever desire.

As per dependent claim 74, Claim 74 recites similar limitations as in Claim 57 and is similarly rejected under rationale.

As per dependent claim 91, Claim 91 recites similar limitations as in Claim 57 and is similarly rejected under rationale.

(10) Response to Argument

On pages 17-29, Appellant argues that Evans et al and AdCycle, alone or in combination, fail to teach or suggest each and every element recited by the claims specifically the limitations "assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system" Specifically, Appellant argues that Evans only discloses producing a single advertisement, not a plurality of advertisements. Thus, Appellant argues since Evans does not teach a plurality of advertisements, it cannot teach storing a plurality of assembled advertisements, as required by the claims and selecting and retrieving one of the previously stored plurality of assembled advertisements when the type of advertisement is selected for transmission to users on an electronic network by an advertising system. (Page 23, second paragraph) Furthermore, Applicant argues that Evans fails to specifically teach rotating through the product references and selecting subsets of product references to assemble a plurality of advertisements. (Page 23, last paragraph) However, the Examiner disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Evans et al discloses each template (a form of aggregate creative definition) may contain multiple ad areas (Paragraph 0069) which each ad area able to contain more than one product references (Paragraph 0068, Page 6, lines 5 – 14; Paragraph 0071.) Therefore, Paragraph 0088 and Paragraph 0095 disclose one embodiment wherein a template and a list of product references are submitted to an assistance layout program that lays out the product references into the template. Here, the computer would read the list of product references, select a product reference from a plurality of product references, obtain the product reference and place it into template based on the instructions of either priority based or order-based from the list. Each product being advertised has multiple product references from which the assistance layout program may choose. Since the program has multiple product references to choose from, it provides greater flexibility creating multiple advertisements. Thus a process of creating a computer-created advertisement, hence using a computer that is used to create ads using an automated assembly. Furthermore, it is implicitly known if the Evans et al's method is capable of performing the functionality once, then it may generate the same functionality over again. Thus multiple computer-created advertisements have the functionality to be generated. Furthermore, as stated, the assistance layout program has

multiple product references to choose from for each ad area displaying a product (product reference). Thus, Evans is suggesting any number of product references related to a product may be chosen when the layout assistance program chooses product references to create an advertisement. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that each time Evans et al's invention is processed to create an advertisement a different product reference may be chosen providing the benefit of providing to the user efficient, time saving method of creating more than one advertisements with different product references.

In addition, the Examiner agrees that Evans et al fails to specifically disclose teach rotating through the product references and selecting subsets of product references to assemble a plurality of advertisements. However, Adcycle discloses the feature of the use of ad groups wherein each group contains multiple ad campaigns (advertisement). The groups are regions on the web page wherein each group rotates the ads based on the ad campaigns in that group. For example, Adcycle disclose the user creating a group to be located on the top of the web page, wherein that group contains multiple ad campaigns, and rotates each ad campaign for each time the group is displayed. Thus, it is implicitly known if Adcycle's method is capable of performing the functionality once for one region, then it may generate another group for a different region. Therefore, Adcycle discloses the ability for multiple locations of ads on the webpage equaling the number of created groups at a time. Each time the groups on the webpage are displayed, a new ad is rotated for display. Thus, each time the web page

is view, a different combination of ads are presented based on the rotation of the ads in each group. (Page 1-2)

It would have been obvious to one of ordinary skill in the art at the time of Application's invention to have modified Evan's advertisements creation method with Adcycle's feature of rotating ads since it would have provided the benefit of a fast and inexpensive method for advertisers that want to place only a limited number of ads.

Furthermore, the claim language of claim limitations "storing the plurality of aggregative creative forms....transmission" does not explicitly state how or where the aggregative creative forms are stored, other than being stored after being "assembled". In addition, the claim language does not explicitly state how many assembled forms are stored before one is selected and transmitted since the claim language is written in a general approach and does not explicitly state the conditions of when the creative is selected. (i.e. when the aggregative creative is selected for transmission") Thus, the claim language still has the ability for an aggregative creative to be selected after it has been made since it the written claim language of the claim limitations does not eliminate that embodiment. Therefore, Paragraph 0048, Step 314 and Claims 1, 16, 39 disclose the creation/generation of a proposed advertisement that is used to be displayed to the user for authorization. The generation of proposed advertisement is defined as the plurality of product references that has been laid out on the plurality of advertisement areas. Thus, when displaying the proposed advertisement to the user, an "assembled form" is presented. In addition, it is inherently known when any data (i.e. advertisement) is created, its stored in a form of memory such as a memory buffer or in a volatile

memory for further operations (i.e. displayed). Furthermore, after authorization/approval, the proposed (assembled) advertisement may be transmitted to users via a printer, email or posted on a web site by Internet. (Paragraphs 0052, 0095, Claim 17)

Therefore, Evans et al in view of Adcycle teach the claim limitations of Claim 46 and its parallel claims.

On pages 29-31, Appellant argues that the teachings of Evans and AdCycle cannot be combined as suggested by the final Office Action to achieve the claimed invention with a reasonable expectation of success or with at least some degree of predictability. Appellant argues that since Adcycle's teaching of rotating is not combinable since Adcycle discloses the rotation occurs at the time that the web page is transmitted wherein Evans discloses the advertisement has already been assembled at the time that it is posted. By this assumption, the Appellant argues the rotation taught by AdCycle cannot occur during assembly of the advertisement; therefore, a system which fails to use rotation during the assembly of a plurality of advertisements fails to resemble the claimed invention. However, the Examiner disagrees.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

According to the claim language of the claim limitation, the claim limitations fail to specifically disclose how and where the advertisements are assembled that comprise the steps of rotating and selecting a plurality of subsets of subcreatives that include different combinations of more than one subcreative. The claim language does not specify whether or not an aggregate creative form or the subcreatives are transmitted to a location during the assembling before storing. Therefore, Evans discloses the the advertisement created may be in electronic format. As stated in the office action, Evans fails to specifically disclose rotating through the at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative.

However, Adcycle discloses the use of ad groups wherein each group contains multiple ad campaigns (advertisement). The groups are regions on the web page wherein each group rotates the ads based on the ad campaigns in that group. For example, Adcycle disclose the user creating a group to be located on the top of the web page, wherein that group contains multiple ad campaigns, and rotates each ad campaign for each time the group is displayed. Thus, it is implicitly known if Adcycle's method is capable of performing the functionality once for one region, then it may generate another group for a different region. Therefore, Adcycle discloses the ability for multiple locations of ads on the webpage equaling the number of created groups at a

time. Each time the groups on the webpage are displayed, a new ad is rotated for display. Thus, each time the web page is view, a different combination of ads are presented based on the rotation of the ads in each group. (Page 1-2) Furthermore, when the webpage is view, the web page displaying the ads is a form an created, assembled advertisement since includes the combination of ads Therefore, despite the Adcycle transmitting the ads and a web page to a client, the combination is assembled at the client for viewing. (Page 1, #7: Discloses putting code onto the webpage HTML, and viewing the page in the browser. It is implicitly known when a web page is viewed in a browser; the HTML page and the content associated with the HTML page to be displayed on the webpage are obtained from one or more servers and are combined/assembled together to be displayed as a web page) In addition, when the assembled web page with the ads is viewed in the browser, the web page with the ads is stored on the client (stored in a form of memory such as a memory buffer or in a volatile memory for further operations) Furthermore, it is implicitly known a file stored in one location can moved (transmitted) to another location (i.e. another computer).

It would have been obvious to one of ordinary skill in the art at the time of Application's invention to have modified Evan's advertisements creation method with Adcycle's feature of rotating ads since it would have provided the benefit of a fast and inexpensive method for advertisers that want to place only a limited number of ads. The Examiner is not combining whole inventions by brute force when the Examiner stated the obvious statement in the previous Office action. The Examiner is modifying Evans et al's advertisement creation method to include the feature of rotating ads that is

disclosed in Adcycle, not the entire invention, based on what is stated in the language of the claim language

On pages 32-33, Appellant argues that the teachings of Evans and AdCycle cannot be combined as suggested by the final Office Action to yield the claimed invention with a reasonable expectation of success or with at least some degree of predictability.; therefore, the final Office Action's attempt to stretch the teachings of Evans and AdCycle to arrive at the claimed invention where such teachings fail to exist strongly suggests that the final Office Action is applying impermissible hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David Faber/

Examiner, Art Unit 2178

Conferees:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Stephen Hong, Supervisory Patent Examiner for Group Art Unit 2178

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